

A2
one of at least two first antitack agents having an oxidic pyrolysis residue and at least one second antitack agent having the oxidic pyrolysis residue and an oxidic fine powder.

20. (Amended) A method for producing a composite material, the method comprising:

A3
pressing a starting material to form a molded article;
pyrolyzing antitack agents to oxides by performing a heating in a nonreducing atmosphere; and
causing the oxides to react with one another to form at least one common phase.

REMARKS

I. Introduction

Claims 1 to 31 are currently pending in this application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants note with appreciation the acknowledgment of the claim for foreign priority and the indication that all of the copies of the certified copies of the priority documents have been received.

Applicants thank the Examiner for considering the previously filed Information Disclosure Statement, PTO-1449 paper and cited reference.

II. Rejection of Claims 1 to 31 Under 35 U.S.C. § 112

Claims 1 to 31 were rejected under 35 U.S.C. § 112, second paragraph as indefinite for allegedly failing to particularly point out and distinctly claim the subject matter of the invention.

The Office Action alleges that the term "high specific resistance" is indefinite. Applicants submit that the claims, as amended herein, are sufficiently definite and

obviate the 35 U.S.C. § 112 rejection. Therefore, withdrawal of the 35 U.S.C. § 112 rejection and allowance of claims 1 to 31 is respectfully requested.

III. Rejection of Claims 1 to 31 Under 35 U.S.C. § 102(b)

Claims 1 to 31 were rejected under 35 U.S.C. § 102(b) as anticipated by EP 0673284 B1 ("EP '284").

Claim 1 relates to a powdered metal composite material. Claim 1 recites that the powdered metal composite material has at least two oxides encapsulating powdered metal particles, the at least two oxides forming at least one common phase.

Claim 9 relates to a starting material. Claim 9 recites that the starting material includes a powdered metal, for production of a powdered metal composite material, one of at least two first antitack agents having an oxidic pyrolysis residue, at least one second antitack agent having the oxidic pyrolysis residue, and an oxidic fine powder.

Claim 20 relates to a method for producing a composite material. Claim 20 recites that the method includes the steps of pressing a starting material to form a molded article, pyrolyzing antitack agents to oxides by performing a heating in a nonreducing atmosphere; and causing the oxides to react with one another to form at least one common phase.

EP '284 purportedly relates to a method of making lubricated metallurgical powder compositions. The lubricant is stated to be provided as a metal salt of a fatty acid and is stated to preferably form an alloy with iron under conventional sintering conditions. See page 3, line 6 and lines 19 to 23. Nowhere does EP '284 disclose, or even suggest, at least two oxides encapsulating powdered metal particles, the at least two oxides forming at least one common phase, as recited in claim 1. Further, nowhere does EP '284 disclose, or even suggest, a starting material including a powdered material, one of at least two first antitack agents having an oxidic pyrolysis residue, and at least one second

antitack agent having the oxidic pyrolysis residue, and an oxidic fine powder, as recited in claim 9. Further yet, nowhere does EP '284 disclose, or even suggest, a method for producing a composite material including the steps of pyrolyzing antitack agents to oxides and causing the oxides to react with one another to form at least one common phase, as recited in claim 20.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that EP '284 does not disclose, or even suggest, at least two oxides encapsulating powdered metal particles, the at least two oxides forming at least one common phase, as recited in claim 1, or a starting material including a powdered material, one of at least two first antitack agents having an oxidic pyrolysis residue, and at least one second antitack agent having the oxidic pyrolysis residue, and an oxidic fine powder, as recited in claim 9, or a method for producing a composite material including the steps of pyrolyzing antitack agents to oxides and causing the oxides to react with one another to form at least one common phase, as recited in claim 20.

Additionally, to reject a claim under 35 U.S.C. § 102, the Examiner must demonstrate that each and every claim limitation is contained in a single prior art reference. See, Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). The Office Action does not present a prima facie case under 35 U.S.C. § 102 as the Office Action's general reference to

the Specification (pages 3 and 4 is practically the entire Detailed Description) of EP '284 is not a sufficient demonstration that each and every claim limitation is contained in a single prior art reference. See Office Action at p.2, par. 4. Still further, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See, Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). In particular, it is respectfully submitted that, at least for the reasons discussed above, the references relied upon would not enable a person having ordinary skill in the art to practice the inventions of the rejected claims, as discussed above. Also, to the extent that the Examiner is relying on the doctrine of inherency, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art." M.P.E.P. § 2112 (emphasis in original); and see, Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, the anticipation rejection as to the rejected claims must necessarily fail for the foregoing reasons.

In summary, it is respectfully submitted that EP '284 does not anticipate independent claims 1, 9 and 20. Therefore, allowance of independent claims 1, 9 and 20 is respectfully requested.

As for claims 2 to 8 and 29, which ultimately depend on claim 1 and therefore include all of the limitations of claim 1, Applicants submit that these claims are patentable for at least the reasons submitted above in support of the patentability of claim 1. Therefore, allowance of claims 2 to 8 and 29 is respectfully requested.

As for claims 10 to 19 and 30 which ultimately depend on claim 9 and therefore include all of the limitations of claim 9, Applicants submit that these claims are patentable for at least the reasons submitted above in support of the patentability of claim 9. Therefore, allowance of claims 10 to 19 and 30 is respectfully requested.

As for claims 21 to 28 and 31, which ultimately depend on claim 20 and therefore include all of the limitations of claim 20, Applicants submit that these claims are patentable for at least the reasons submitted above in support of the patentability of claim 20. Therefore, allowance of claims 21 to 28 and 31 is respectfully requested.

IV. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Attached hereto is a marked-up version of the changes made to the claims by the current Amendment. The attached page is captioned "**Version with Markings to Show Changes Made.**"

Respectfully submitted,

KENYON & KENYON

Dated: July 3, 2003

By: Richard L. Mayer
Reg. No. 22,490

One Broadway
New York, New York 10004
(212) 425-7200

CUSTOMER NO. 26646



26646

PATENT TRADEMARK OFFICE

Version with Markings to Show Changes Made

IN THE CLAIMS:

Claims 1, 9 and 20 have been amended without prejudice as follows:

1. (Amended) A powdered metal composite material [having a high specific electrical resistance], comprising:

at least two oxides encapsulating powdered metal particles, the at least two oxides forming at least one common phase.

9. (Amended) A starting material, comprising:

a powdered metal for production of a powdered metal composite material [having a high specific electrical resistance]; and

one of at least two first antitack agents having an oxidic pyrolysis residue and at least one second antitack agent having the oxidic pyrolysis residue and an oxidic fine powder.

20. (Amended) A method for producing a composite material [having a high specific electrical resistance], the method comprising:

pressing a starting material to form a molded article;
pyrolyzing antitack agents to oxides by performing a heating in a nonreducing atmosphere; and

causing the oxides to react with one another to form at least one common phase.